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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,243	12/10/2001	Balraj S. Parmar	5853-184US	4551

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EXAMINER	
METZMAIER, DANIEL S	
ART UNIT	PAPER NUMBER
1712	4

DATE MAILED: 10/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,243

Applicant(s)

PARMAR ET AL.

Examiner

Daniel S. Metzmaier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Claims 1-18 are pending.

#### ***Priority***

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

#### ***Claim Rejections - 35 USC § 112***

3. Claim 14<sup>1</sup> provides for the use of a microemulsion formed by the method of claim 1, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 14 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim 14 has not been further treated on the merits.

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<sup>1</sup> Claim 14 has not been treated on the merits. Upon amendment of claim 14, said claim may be subject to a restriction depending on said amendment.

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4. Claims 1-13 and 15-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. While applicants set forth an oil in water emulsion, the body of the claims do not provide for the water and/or aqueous phase of the oil in water emulsion.

In claim 3, "the final product" lacks antecedent basis.

In claims 8 and 9, it is unclear what the reference to "said surfactant" refers. It is unclear whether it refers to the surfactant mixture or the ionic surfactant. Please note claims 8 and 9 are dependent on claim 7, which defines the ionic surfactant but claim 6 defines the surfactant mixture.

Claims 10 and 11 are indefinite because it is unclear whether the concentrate that is formed by the higher concentrations is an oil in water microemulsion or merely forms said oil in water microemulsion as a concentrate therefore.

#### ***Claim interpretation***

5. The methods of making (claims 1-13) read on mere mixing of the components set forth therein. It is generally accepted that at least nominal mixing is required for emulsion formation.

#### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. Claims 1, 3, 13, 15 and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hagarty, US 5,792,465. See column 4, line 55 to column 5, line 15 and claims. The Exxsol D-95 is characterized as a solvent and not an oil of claims 1 and 3. The pyrethrum, piperonyl butoxide and permethrin disclosed in the example and reading on the concentrations of claim 3 are claimed in the alternative to the neem oil. See column 1, lines 44-48, for the microemulsion droplet size.

The method step of mixing would have been inherent to the microemulsion formation.

8. Claims 1-8, 10, 12-13 and 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Behan et al, US 5,374,614. See examples. See example 6, which discloses a single ethoxylated surfactant and oil. See examples 3, 4, 7 and 8 for combinations of nonionic and anionic surfactants. The droplet size range of claim 13 is inherent to the microemulsions disclosed in the Behan et al reference.

Claim 12 is included in the rejection because the Behan et al reference discloses (column 4, lines 59-65, and column 8, lines 23-28) and claims (claims 1 and 3) less than 10% w/w of lower aliphatic alcohol or less than 1% w/w lower aliphatic alcohol. The Behan et al reference clearly contemplates the incorporation of lower alcohols in the

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disclosed and claimed compositions including those represented by the exemplified compositions.

The method step of mixing would have been inherent to the microemulsion formation.

9. Claims 1-2, 4-5, 10-11, 13 and 15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Narayanan et al., 6,045,816. Narayanan et al (example 1) discloses a oil in water microemulsion concentrate. It is noted that water is not provided for in the body of the claims. Furthermore, Narayanan et al comparative example 17 discloses an emulsifiable concentrate of a single surfactant comprising nonylphenol ethoxylate.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Behan et al, US 5,374,614. Behan et al discloses microemulsions as set forth in the above anticipation rejection.

Behan et al differ from claim 9 in the use of nonyl phenol ethoxylate and alkyl benzene sulfonate at a surfactant to oil ratio of 3 : 1 w/w.

Behan et al (example 6, A) set forth conventional solubilization of the oil employing in excess of three times the amount of surfactants. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ conventional concentrations of the surfactants for the advantage of improved emulsification and emulsion stability.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (703) 308-0451. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on (703) 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Daniel S. Metzmaier  
Primary Examiner  
Art Unit 1712

DSM  
September 30, 2002